

U.S. Patent Application Serial No. 10/607,891
Reply to Office Action dated March 16, 2006

Remarks:

Applicants have read and considered the Office Action dated March 16, 2006 and the references cited therein. Claims 1-57 are currently pending.

In the Action, Applicants note that priority to U.S. Application Serial No. 10/442,495 was claimed and that the originally application including transmittal sheet requesting amendment of the application to insert the priority claim. Applicants further note that the filing receipt indicated this priority, but did not include the priority claim to the International application. A Request for a Corrected Filing Receipt was filed on February 11, 2004 and on May 6, 2004. Applicants assert that the prior application claimed priority to the PCT application. Applicants note that the original priority claim had been made in a timely manner. Applicants have enclosed a Petition to Amend the Application to recite the entire priority claim and to grant the full benefit of the priority claim to the parent application and the PCT application.

Claims 1-57 were rejected under 35 U.S.C. § 101 under statutory double patenting. Applicants assert that U.S. Patent Application Serial No. 10/442,495 has gone abandoned. Applicants assert that the statutory double patenting rejection is therefore moot. In addition, claims 1-57 were provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1-57 of co-pending Application No. 10/442,495. Applicants assert that Application Serial No. 10/442,495 has gone abandoned and that the provisional double patenting rejection is moot.

Claims 1-15, 15, 16, 18, 21-34, 36, 37, 39, 40, 42, 44, 48, 49, 52, 53 and 56 were rejected under 35 U.S.C. § 102(b) as being anticipated by Rembrand et al., WO 02/09473 A2. The Office Action states that Rembrand anticipates all limitations of claim 1 and the other rejected claims. Applicants assert that the present invention claims priority to an application that was filed prior to the publication date of reference WO 02/09473 A2. Moreover, the priority applications fully support the rejected claims. Therefore, Applicants assert that Rembrand PCT publication is not a

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proper prior art reference to the present application under 35 U.S.C. § 102(b). Applicants assert that the claimed invention is fully supported by the disclosure of the earlier applications. Applicants therefore assert that the present application overcomes the rejection under 35 U.S.C. § 102(b).

Claims 6 and 51 were rejected under 35 U.S.C. § 102(b) as being anticipated by Rembrand in view of Mackie 1202VLZ Pro Mixer Owner's Manual. The Action states that the Owner's Manual sets forth inherent properties of the Mackie Pro Mixer disclosed by Rembrand and asserts that Rembrand anticipates all of the limitations of these claims. Applicants assert that the cited Rembrand reference is not prior art under 35 U.S.C. § 102(b) as discussed above. Therefore, Applicants assert that the anticipation rejection of Rembrand in view of Mackie is not proper and should be withdrawn.

Claims 1, 20, 21 and 35 were rejected under 35 U.S.C. § 102(b) as being anticipated by Kandel et al. The Office Action states that claim 1 is limited to a system for enhancing the hearing of certain sounds and states that Kandel discloses a signal processing circuit and method for increasing speech intelligibility. Moreover, the Office Action asserts that Kandel discloses a speaker that corresponds to the "electro-acoustic transducer" as recited and a mixer 113 that corresponds to the "compensatory signal generator" as recited. The mixer 113 generates a "compensatory signal" based on the output from filter 120, which corresponds to a "compensatory waveform" based on "otoacoustic emissions" received by microphone 118. The Office Action states that therefore, Kandel anticipates all limitations of the claim.

Applicants assert that the Kandel reference does not anticipate each and every limitation of the rejected claims. Applicants assert that the speaker 117 does not correspond to an "electro-acoustic transducer" as the Office Action fails to consider the further limitation that the electro-acoustic transducer produces sounds *in the vicinity of the ear*. Applicants assert that the present invention includes an earphone and the cited reference only provides a speaker, which would not be obvious to one of ordinary skill in the art. Applicants assert that a speaker is not a non-

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obvious element for an earphone. Applicants assert that the Kandel reference does not provide the electro-acoustic transducer for producing sounds in the vicinity of an ear according to signals provided thereto. Applicants further assert that the compensatory waveform is not determined according to ear otoacoustic emissions. Therefore, Applicants assert that the rejection of claim 1 to Kandel should be withdrawn. Applicants further assert that Kandel does not teach or suggest the limitations of claims 20, 21 and 35 for at least the same reasons.

Claims 43, 45, 46, 47 and 50 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rembrand. Applicants assert that Rembrand is not prior art to the present application for at least the reasons discussed above. Applicants therefore request that the rejection under 35 U.S.C. § 103(a) over Rembrand be withdrawn.

Claims 19, 54 and 55 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rembrand in view of Bauer. Applicants assert that Rembrand is not prior art to the present application for at least the reasons discussed above. Applicants therefore request that the rejection under 35 U.S.C. § 103(a) of Rembrand in view of Bauer be withdrawn.

Claims 7-12, 38 and 41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rembrand in view of Stockham, Jr. et al., in view of Anderson. Applicants assert that Rembrand is not prior art to the present application for at least the reasons discussed above. Applicants therefore assert that the rejection over the combination of Rembrand and the other prior art should be withdrawn.

Finally, claims 14 and 57 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rembrand in view of Stockham in view of Anderson and further in view of Sandlin. Applicants assert that Rembrand is not prior art for at least the reasons discussed above. Applicants therefore request that the rejection under 35 U.S.C. § 103(a) be withdrawn.

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Applicants assert that the claims are in condition for allowance. A speedy and favorable action on the merits is hereby solicited. If the Examiner feels that a telephone interview may be helpful in this matter, please contact Applicant's representative at (612) 336-4728.



Respectfully submitted,

MERCHANT & GOULD P.C.

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